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Jordan Pollack

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EXAMINER

CHAO, MICHAEL W

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/915,425 | <b>Applicant(s)</b><br>POLLACK, JORDAN |  |
|                              | <b>Examiner</b><br>Michael Chao      | <b>Art Unit</b><br>2442                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 38 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 38 recites a system means for claim. While physical elements are present in the function portion of the 'means for' clauses, the 'means for' clauses themselves constitute software. Software is none of a process, machine, manufacture, nor composition of matter; and as such is non-statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-8, 14, 16-26, 28, 38, 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US 7054905), in view of Karim (U.S. 6654892).

With respect to claims 1, 18, 19, 25, 38, 39, Hanna teaches; A system for management and manipulation of stored files through electronic mail items comprising: a first receiving portal configured to receive, from a sender, a first electronic mail item addressed to a recipient, wherein the first electronic mail item comprises a file;

1 (“sender 102 sends email message 202 (including attachment 204) to email server 108”

2 Hanna column 4 line 20)

3 a mail processor configured to produce a stripped electronic mail item by  
4 removing the file from the first electronic mail item and replacing it with a corresponding  
5 file handle; (“Email server 108 also forwards email message 292 along with URL”

6 Hanna column 4 line 31)

7 a storage device configured to store the file; (“Email server 108 sends  
8 attachment 204 to file server 111” Hanna column 4 line 30)

9 a mail deliverer configured to send the stripped electronic mail item to the  
10 recipient; (“Email server 108 also forwards email message 292 along with URL” Hanna  
11 column 4 line 31)

12 a rights verifier configured to determine whether the recipient has privilege to  
13 access the stored file corresponding to said file handle; (“DIE 110 keeps track of a set of  
14 recipients specified in a distribution list” Hanna column 3 line 65)

15 a second receiving portal configured to receive, from the recipient including a first  
16 field which contains a user identification, a second field which contains the file handle  
17 (“In order to receive attachment 204, recipient 114 may have to be authenticated to file  
18 server 111” Hanna column 5 line 62)

19 Hanna does not teach;

20 a second electronic mail item including a first field which contains a user  
21 identification, a second field which contains the file handle, and a third field which  
22 contains a command specification, without prompting for the email item;

1 a file handle recognizer configured to locate a file handle pattern within the  
2 electronic mail item; and

3 a command executor configured to execute said command specification on the  
4 file retrieved from said storage device when the recipient is verified to have the access  
5 rights to the file.

6 Karim teaches such limitations;

7 configured to receive, from the recipient a second electronic mail item including a  
8 first field which contains a user identification, ("if it is determined at block 504 that the  
9 password is invalid, the e-mail is ignored" Karim column 6 line 40) a second field which  
10 contains the file handle, and a third field which contains a command specification,  
11 without prompting for the email item; ("the command is obtained from the client e-mail at  
12 block 706 and the associated file name is obtained at block 708" Karim column 8 line  
13 57)

14 a file handle recognizer configured to locate a file handle pattern within the  
15 electronic mail item; and ("the command is obtained from the client e-mail at block 706  
16 and the associated file name is obtained at block 708" Karim column 8 line 57)

17 a command executor configured to execute said command specification on the  
18 file retrieved from said storage device when the recipient is verified to have the access  
19 rights to the file. ("The execution engine may therefore identify the command data  
20 structure and retrieve any associated files" Karim column 9 line 30)

1           A person of ordinary skill in the art would have combined the invention of Karim  
2 with Hanna by including an email file transaction system as shown in Karim into the file  
3 server of Hanna.

4           It would have been obvious at the time the invention was made to a person of  
5 ordinary skill in the art to include a file transaction system to allow users to control  
6 access and update the file on the file server.

7           Regarding claim 2, the combination discussed above teaches; wherein the file  
8 handle recognizer is configured for locating conforming file handle patterns within the  
9 body of the electronic mail item. ("the command is obtained from the client e-mail at  
10 block 706 and the associated file name is obtained at block 708" Karim column 8 line  
11 57)

12           Regarding claim 4, the combination discussed above teaches; further including a  
13 command parser which recognizes and assembles a command out of the information  
14 extracted from the electronic mail item. ("The execution engine may therefore identify  
15 the command data structure and retrieve any associated files" Karim column 9 line 30)

16           Regarding claim 6, the combination discussed above teaches; wherein the  
17 command specification instructs said command executor to retrieve the file as an email  
18 attachment. ("where the client code control command is a check out command, the  
19 content of the file being checked out of the source code control system may be provided  
20 as an attachment file" Karim column 7 line 22)

21           Regarding claim 7, the combination discussed above teaches; wherein the  
22 command specification instructs said command executor to forward the file to a third

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1 party as an email attachment. (“the system allows recipient 114 to forward URL 206 to  
2 another recipient” Hanna column 6 line 32)

3       Regarding claim 8, the combination discussed above teaches; wherein the  
4 command specification instructs said command executor to forward to a third party (“the  
5 system allows recipient 114 to forward URL 206 to another recipient” Hanna column 6  
6 line 32) a newly constructed (“it may be desirable to use a different URL to refer to the  
7 same file, so that the file can be copied” Hanna column 5 line 20) file handle to the file  
8 stored on said storage device.

9       Regarding claim 14, the combination discussed above teaches; wherein the  
10 storage device further includes an automatic deletion timer associated with at least one  
11 of the stored files. (“the system deletes attachment . . . automatically after an expiration  
12 of a time period” Hanna column 6 line 17)

13       Regarding claim 16, the combination discussed above teaches; wherein said file  
14 handle is a uniform resource locator. (“recipient 114 uses URL 206 to send a request  
15 208 for attachment” Hanna column 4 line 32)

16       Regarding claim 17, the combination discussed above teaches; wherein the  
17 storage device is chosen from the group consisting of hard drives, optical drives,  
18 random access memories, tape drives, RAID arrays, and storage area networks. (“disk  
19 drive” Hanna column 3 line 24)

20       Regarding claims 20, 21, 22, 23, 24, The combination discussed above teaches;  
21 hard drive (“disk drive” Hanna column 3 line 24), optical drive (“CDs and DVDs” Hanna

column 3 line 24), ROM, RAM, (Karim column 11 line 30) and a tape drive. ("magnetic tape" Hanna column 3 line 24)

Regarding claims 26, 28, the combination discussed above teaches a general-purpose computer system. (Karim column 11 line 24)

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination discussed above, in view of Hussey (U.S. 5826269), in view of Checkoway et al. (US 20020035607)

Regarding claim 3, the combination discussed above teaches; further including a user identification system which extracts information from the electronic mail item including the from address, destination address ("the present invention preferably handles only those e-mails that are addressed to the source code control system" Karim column 4 line 57), the subject, the reply-to, and the body of the electronic mail item ("implement a password or identifier code" Karim column 4 line 57), to enable verification of the sender as a known user of the system. ("any number of authentication mechanisms" Hanna column 5 line 65). The combination discussed above may not explicitly recite that the 'from address', the subject, or the 'reply-to' fields are used in determining the sender. teaches a from address, and a subject extraction; "the subject field is utilized in conjunction with . . . in order to process the email request in a specific manner" (Hussey column 8 line 50); "whether the identified sender is authorized to submit the SQL request" (Hussey column 8 line 30). A person of ordinary



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1 skill in the art would have used the invention of Hussey with the combination discussed  
2 above by explicitly using the from and subject fields in command requests to separate  
3 password and command identifiers. It would have been obvious at the time the  
4 invention was made to a person of ordinary skill in the art to use these fields in order to  
5 create a command structure compatible with legacy email systems. Furthermore, this  
6 combination does not disclose the use of a 'reply-to' field. Checkoway discloses that a  
7 'reply-to' field may be used in lieu of a from field in determining the sender of an email.  
8 A person of ordinary skill would have used this concept of Checkoway with the  
9 combination discussed above by further using a reply-to field to determine the identity of  
10 the requester of the service. It would have been obvious at the time the invention was  
11 made to a person of ordinary skill in the art to use the reply-to field to determine the  
12 identity of a sender since it should also represent the sending entity.

13  
14  
15 Claims 5, 9, 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over  
16 the combination discussed above, in view of Boaz et al. (U.S. 5333266).

17 Regarding claim 5, the combination discussed above does not explicitly teach;  
18 wherein the command specification instructs said command executor to delete the file  
19 from said storage device. Boaz teaches such a feature; "From the file option, a user can  
20 select Properties, Move, Discard, Send and Dial operations." (Boaz column 21 line 12).  
21 A person of ordinary skill would have used the file operations of Boaz with the invention  
22 of the combination discussed above by allowing further command options to a user of  
23 the system. It would have been obvious at the time the invention was made to a person

1 of ordinary skill in the art to use the features of Boaz with the combination discussed  
2 above in order to accommodate common file handling operations.

3       Regarding claim 9, the combination discussed above does not teach; wherein the  
4 command specification instructs said command executor to print the file on a fax  
5 machine at a specified telephone number. Boaz teaches such a feature; "image or text  
6 document be faxed to a remote phone number for review" (Boaz column 24 line 45). A  
7 person of ordinary skill would have used the file operations of Boaz with the invention of  
8 the combination discussed above by allowing further options to a user of the system. It  
9 would have been obvious at the time the invention was made to a person of ordinary  
10 skill in the art to use the features of Boaz with the combination discussed above in order  
11 to allow "a request from a local terminal to access message functions from a foreign  
12 messaging system." (Boaz column 2 line 23)

13       Regarding claim 10, the combination discussed above does not explicitly teach;  
14 further including at least one of an optical character recognition device, automatic  
15 speech recognition device, language translation device, and a file format translation  
16 device associated with said command executor. Boaz teaches such a feature; "Also in  
17 memory 100 are Text to Speech and Speech to Text Code Module 140, and Optical  
18 Character Recognition to Text . . ." (Boaz column 7 line 43). A person of ordinary skill in  
19 the art at the time of invention would have combined the conversion tools of Boaz with  
20 the combination discussed above by converting received attachments to required  
21 formats. It would have been obvious at the time the invention was made to a person of  
22 ordinary skill in the art to use the conversion tools of Boaz with the combination

discussed above in order to allow a "document or a portion thereof [to] be reviewed" (Boaz column 24 line 30).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination discussed above, in view of Pearl et al. (US 20020083035).

Regarding claim 11, the combination discussed above does not explicitly disclose; wherein the command specification instructs said command executor to convert the file to plain text and email it back to the sender. Pearl discloses such a feature; "translates the content to a text format compatible for display on the wireless device" (Pearl paragraph [0006]). A person of ordinary skill in the art would have used the conversion method of Perl with the combination discussed above by converting the file to a format usable by the receiving device. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to enable the combination discussed above to perform this conversion in order to allow a user to "view the text data on [a] wireless device from the delivered e-mail message" (Pearl paragraph [0006]).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination discussed above in view of Boaz, in view of Tverskoy et al. (US 20010043678).

Regarding claim 12, the combination discussed above does not teach wherein the command specification instructs said command executor to convert the file to an audio file and to forward the audio file to a telephone at a specified number. Boaz discloses the conversion to an audio file with the reasoning listed in this office action in claim 10. Further, this combination does not explicitly disclose that the audio file is

1 forwarded to a telephone number. This is taught by Tverskoy; "E-mail command  
2 messages may also be used to cause answering machine 12 to place a telephone call  
3 and play a recorded message." (Tverskoy paragraph [0038]). A person of ordinary skill  
4 in the art would have used the call feature of Tverskoy with the combination above by  
5 allowing a command to allow text documents to be dictated over a telephone line. It  
6 would have been obvious at the time the invention was made to a person of ordinary  
7 skill in the art to use the call feature of Tverskoy with the combination above in order to  
8 "document or a portion thereof [to] be reviewed" (Boaz column 24 line 30).

9 Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the  
10 combination discussed above, in view of Martin (US 6432232)

11 Regarding claim 13, the combination discussed above does not teach; wherein  
12 the command specification instructs the command executor to print the file at a printer,  
13 and to instruct a mailing component to insert the printed file into a postal mail system.  
14 Martin teaches said feature; "it is an object of the subject invention to provide an  
15 inexpensive system that can automatically generate finished letter mail, of several  
16 pages if desired, at lightly attended remote terminals, so long as the system is  
17 electronically connected to a computer, anywhere in the world when tied to the internet  
18 and E-mail" (Martin column 1 line 66). A person of ordinary skill in the art would have  
19 combined the invention of Martin with the combination discussed above by using a  
20 device like Martins with the combination discussed above and allowing interoperation  
21 thereof. It would have been obvious at the time the invention was made to a person of

1 ordinary skill in the art to include such a device in order to allow for a sender “to be sure  
2 that the recipient gets a hard copy” of the mail. (Martin column 1 line 65).

3 Claim 15, is rejected under 35 U.S.C. 103(a) as being unpatentable over the  
4 combination discussed above, in view of Ryan et al. (US 6205434)

5 Regarding claim 15, the combination discussed above does not explicitly  
6 disclose; wherein the command specification instructs the command executor to change  
7 the date of autodeletion of the file. Ryan discusses such a deletion timer; “At Input Block  
8 352, the user enters the delete-date” (Ryan column 32 line 60). A person of ordinary  
9 skill in the art would have used the input of Ryan with the system of Karim by allowing a  
10 user to set a date that the file should be discarded. It would have been obvious at the  
11 time the invention was made to a person of ordinary skill in the art to use a delete date  
12 with Karim in order to free up space from unused files on the system.

13 Claims 27, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
14 the combination discussed above, in view of Gates (US 4969083)

15 Regarding claims 27, 29, the combination discussed above does not explicitly  
16 disclose a programmable logic controller, or an array of network servers. Gates  
17 discloses both as processing apparatuses. A person of ordinary skill in the art would  
18 have used a PLC or an array of servers with the invention discussed above by installing  
19 the system software on either host machine. It would have been obvious at the time the  
20 invention was made to a person of ordinary skill in the art to use a PLC or an array of  
21 servers dependent upon the capacity requirement of the system install.

22

***Response to Arguments***

Applicant's arguments, see pages 11-13, filed 04/06/2009, with respect to the rejection(s) of claim(s) 1, 18, 19, 25 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hanna in view of Karim.

Applicants argument that Karim does not teach all the elements of claim 3 is persuasive. Karim does not explicitly recite using a subject, or a 'reply-to' field. Karim, however, does use the 'from address', the 'destination address' and the body of an email. It is necessary for Karim to extract the 'from address' in order to compose "acknowledgment email 118' (column 4 line 25), the use of a destination address is also required, as it would need to be addressed to the system as shown in Karim column 4 line 55 "the present invention preferably handles only those e-mails that are addressed to the source code control system". Furthermore, the body is extracted and parsed for the 'password' or 'identifier' 108 and the control command 212 (column 4 line 60). Therefore, at least those fields are used to ascertain whether the sender is a known user of the system.

Applicant's further arguments depend on those treated, and are persuasive for the reasoning discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chao whose telephone number is (571)270-5657. The examiner can normally be reached on 8-4 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C./  
Examiner, Art Unit 2442

/Andrew Caldwell/  
Supervisory Patent Examiner, Art  
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